

REMARKS

In response to the final Office Action dated November 18, 2009, the Assignee respectfully requests continued examination and reconsideration based on the above amendments and on the following remarks.

Claims 1, 3-18, and 20-25, 27-30, and 32 are pending in this application.

Objection to Drawings

The Office objected to the drawings for failing to show “*denying local storage of the clickstream data.*” The term “*denying*” has been deleted and replaced with “*eliminating*,” which finds support at least at page 13, lines 6-7 of the as-filed application (explaining “this eliminates the requirement that the viewer appliance 328 record the user commands”). The Office is respectfully requested to re-examine the drawings and claims.

Rejection of Claims under § 112

The Office rejected claims 1, 3-8, and 9-17 under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. Independent claims 1 and 9 have been amended to recite “*eliminating local storage of the clickstream data at the viewer appliance by performing in parallel: i) executing the clickstream data and ii) concurrently forwarding the clickstream data from the viewer appliance to a remotely located component to eliminate delay perceived by a viewer.*” Support may be found at least at page 9, lines 5-9 and at page 13, lines 6-7 of the as-filed application. The Assignee thus respectfully asserts that the written description requirement is completely satisfied.

Rejection of Claims under § 103 (a)

The Office rejected claims 18 and 20-32 under 35 U.S.C. § 103 (a) as being obvious over U.S. Patent 7,212,979 to Matz, *et al.* in view of U.S. Patent Application Publication 2002/0100064 to Ward, *et al.*

1. *Matz & Ward* Fails to Teach/Suggest All Claimed Features

The combination of *Matz* with *Ward* fails to teach or suggest all the claimed features. Independent claim 18, for example, recites “*a transfer mechanism ... that immediately forwards the user commands upon receipt through the distribution network to a remotely located component*” (emphasis added). Independent claim 18 also recites “*a control mechanism that executes the user commands in parallel with the transfer mechanism*” (emphasis added). Support may be found at least at page 5, lines 19-23 and at page 9, lines 5-9. Independent claims 23 and 25 recite similar features.

At least these features are not obvious over *Matz* with *Ward*. *Matz* describes a subscriber-action database. *See* U.S. Patent 7,212,979 to Matz at column 6, lines 15-16. As a subscriber makes viewing choices, the choices are transmitted to the subscriber-action database. *See id.* at column 6, lines 26-30. *Ward* modifies a “program click reference” (or “PCR”) field in an HDTV bitstream. U.S. Patent Application Publication 2002/0100064 to Ward, *et al.* at [0021]. A “PCR stamper” is coupled to a Global Positioning System receiver or a SONET interface. *See id.* at [0022]. The PCR stamper receives a global time from the GPS receiver and “restamps the PCR fields within each MPEG compliant bitstream such that all the bitstreams contain the time of day generated by the GPS receiver.” *See id.* at [0022] (emphasis added). The bitstreams are then “organized” into a transport stream and coupled to the SONET interface. *See id.* at [0022]. A SONET network then distributes the transport stream to the television studios for broadcast. *See id.* at [0022]. Still, though, *Matz* with *Ward* fails to teach or suggest “*a transfer mechanism ... that immediately forwards the user commands upon receipt through the distribution network to a remotely located component*” and “*a control mechanism that executes*

the user commands in parallel with the transfer mechanism" (emphasis added). One of ordinary skill in the art, then, would not think that independent claims 18, 23, and 25 are obvious over *Matz* with *Ward*.

Claims 18 and 20-32, then, cannot be obvious. Independent claims 18, 23, and 25 recite distinguishing features, and their dependent claims incorporate these features and recite additional features. Claims 18 and 20-32 cannot be obvious, so the Office is respectfully requested to remove the § 103 (a) rejection of these claims.

2. *Matz & Ward Teaches Away*

The proposed combination of *Matz* with *Ward* teaches away and cannot support a *prima facie* case for obviousness. The M.P.E.P. expressly explains several situations in which a reference teaches away, including when a proposed modification "change[s] the principle of operation of a reference." *See* M.P.E.P. § 2145 (X)(D). If *Matz* is combined with *Ward*, as the Office proposes, then *Matz*'s principle of operation must be impermissibly changed. Indeed, the Assignee previously presented compelling evidence that *Matz*'s principle of operation must be drastically changed to incorporate *Ward*'s "PCR Stamper." As the Assignee explained, *Ward*'s PCR stamper receives a global time from the GPS receiver and "restamps" PCR data fields within MPEG bitstreams to "contain the time of day generated by the GPS receiver." Because the patent laws prohibit these changes, the proposed combination of *Matz* with *Ward* cannot support a *prima facie* case for obviousness.

The Office's rebuttal is improper. The Office responded to the above teaches away argument by repeating the obvious rejection. The Office, in particular, argues that "*Ward* only serves as prior art to teach a known technique of extracting ... timing information." Examiner Peng, Final Action mailed November 18, 2009, at page 6, paragraph 8 ("Examiner's response"). Examiner Peng further argued that the *KSR* ruling allows "known work in one field of endeavor" may prompt predictable variations in the same or different field "based on design incentives." *See id.*

This rebuttal is improper. **A reference must be considered as a whole, including portions that lead away from the claimed invention.** See M.P.E.P. at § 2141.02; *see also W.L. Gore & Assoc., Inc. v. Garlock, Inc.*, 220 U.S.P.Q. (BNA) 303 (Fed. Cir. 1983), *cert. denied*, 469 U.S. 851 (1984). It seems the Office wants to “cherry pick” only certain teachings of *Ward* and ignore teachings that are unfavorable. The patent laws, however, forbid such action, and the Office is, instead, required to consider the whole teachings of a reference. Because *Matz*’s principle of operation must be drastically changed to incorporate *Ward*’s “PCR Stamper,” the Office must respectfully remove the § 103 (a) rejection of these claims.

Moreover, the Office is procedurally incorrect. When an applicant argues impermissible changes, the burden shifts to the Examiner. The Examiner may acquiesce, or the Examiner has the burden to explain why changes to a principle of operation are not required. Merely repeating the obvious rejection is not responsive.

Matz with *Ward* thus teaches away. If *Matz* is combined with *Ward*, as the Office proposes, then *Matz*’s principle of operation must be impermissibly changed to receive MPEG streams and use *Ward*’s PCR stamper to “restamp” PCR data fields within the MPEG bitstreams to “contain the time of day generated by the GPS receiver.” These changes, however, are forbidden to make a *prima facie* case. The proposed combination of *Matz* with *Ward*, then, cannot support a *prima facie* case for obviousness, so the Office is required to remove the § 103 (a) rejection of the pending claims.

If any issues remain outstanding, the Office is requested to contact the undersigned at (919) 469-2629 or scott@scottzimmerman.com.

Respectfully submitted,



Scott P. Zimmerman
Attorney for the Assignee
Reg. No. 41,390